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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,100	09/10/2003	Paul Albert Sagel	9031	4328
27752 7590 10/05/2009 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
EXAMINER				
ROBERTS, LEZAH				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
10/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,100

Applicant(s)

SAGEL ET AL.

Examiner

LEZAH W. ROBERTS

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10, 19-28, 30, 31, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10, 19-28, 30, 31, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' arguments, filed June 4, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This Office Action is made Non-Final.

Claims

Claim Rejections - 35 USC § 103 – Obviousness (New Rejections)

1) Claims 8-10, 19, 20 and 22-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Leaderman (2002/0061329). The rejection is maintained and further applied to claim 34. The rejection is withdrawn in regards to claim 23-27.

Applicant's Arguments

Applicant argues they can find no teaching in Leaderman relating to how any of the methods of coating listed in Leaderman would lead to a product which would have void spaces which would extend through the thickness of the film (claim 19), through the thickness of the mesh (claim 23) or would result in a partial filling of the mesh (claims 23 and 28). Additionally, if considered an inherent property, inherency may not be

established by "probabilities or possibilities" and "The mere fact that a certain thing may result from a given set of circumstances is not sufficient".

Examiner's Response

The Examiner disagrees and submits that Leaderman discloses that the sheet may be impregnated with the disclosed gel. The backing layer may be porous and have holes, which suggest the holes extend through the device for the covered area to breath. The films and gels are used to coat fibers of an absorbent gauze dressing, porous, or micro porous fabric. These fabrics have holes and the compositions coat the fibers, which suggest that the holes are not filled completely, thereby encompassing the limitation partially filling and voids that extend through the film as recited in the instant claims. Further, as previously stated, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of

ordinary skill in the art would employ.” KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007).

The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” Id. at 1742. Applicant has not shown that the device of the instant claims show an improvement over that of the prior art by showing the improvement is more than predictable use of prior art elements according to their established functions. Leaderman provides a substrate similar to that recited in the instant claims by disclosing gauze or porous substrates. The reference further teaches that the fibers of these substrates are covered with the films or gels. It further discloses the pores are so that the covered area may breathe. These factors strongly suggest that the devices of Leaderman have voids that extend through the thickness of the film.

In regards to claim 34, when the substrate is gauze, it is reasonable to conclude that the gauze has a repeating geometric shape.

2) Claims 10, 19, 20, 22-24, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US 2005/0260544). The rejection is maintained and withdrawn in regards to claims 23 and 24.

Applicant's Arguments

Applicant argues they can find no teaching in Jones relating to how absorbing or impregnating the absorbent material with a gel would lead to a product which would have void spaces which would extend through the thickness of the film (claim 19), through the thickness of the mesh (claim 23) or would result in a partial filling of the

mesh (claims 23 and 28). Additionally, if considered an inherent property, inherency may not be established by "probabilities or possibilities", and "The mere fact that a certain thing may result from a given set of circumstances is not sufficient", In re Oelrich, 212 USPQ 323,326 (CCPA 1981). In addition, the Office Action points to no teaching in Jones relating to the plurality of fibers in the mesh comprising a water hydratable polymer as recited in claim 23.

Examiner's Arguments

The Examiner disagrees and submits that Jones discloses that the whitening gel may be impregnated into the absorbent's material's bulk. The oral care layer may also be in the form of a perforated layer, encompassing voids. When a perforated film is on a porous backing layer, which may be porous and have holes, this suggests the holes extend through the device. Further since some of the film and gel may be absorbed or remain unabsorbed as a surface layer, this suggests that the holes are not filled completely, thereby encompassing the limitation partially filling and voids that extend through the film as recited in the instant claims. Further, as previously stated, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the

predictable use of prior art elements according to their established functions.” (*Id.*).

Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742. Applicant has not shown that the device of the instant claims show an improvement over that of the prior art by showing the improvement is more than predictable use of prior art elements according to their established functions. Jones provides a substrate similar to that recited in the instant claims by disclosing gauze or porous substrates and a film that may be perforated. These factors strongly suggest that the devices of Jones have voids that extend through the thickness of the film.

3) Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US 2005/0260544) in view of Ruben (US 6,146,655).

Applicant's Arguments

Applicant argues that Jones in view of Ruben does not establish a *prima facie* case of obviousness because the combination does not teach or suggest all of the claim limitations of independent claim 19, from which claim 7 depends. The deficiencies of

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Jones with respect to independent claim 19 are discussed above and the Office Action points to no teaching in Ruben which would cure its deficiencies.

Examiner's Response

In regards to Jones et al., see Examiner's Response above. Ruben discloses the parameters of fiber used in drug delivery systems and therefore fills the deficiencies of Jones et al.

4) Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US 2005/0260544) in view Chen et al. (US 6,261,679). The rejection is maintained and further applied to claims 23-27 and 33.

Applicant's Arguments

Applicant argues that Jones in view of Chen does not establish a *prima facie* case of obviousness because the combination does not teach or suggest all of the claim limitations of independent claim 19, from which claim 21 depends. The deficiencies of Jones with respect to independent claim 19 are discussed above and the Office Action points to no teaching in Chen which would cure its deficiencies.

Examiner's Response

In regards to Jones et al., see Examiner's Response above. Chen discloses the benefits of using hydratable polymers as fibers in dental absorbents and therefore fills the deficiencies of Jones et al. In regards to 23-27, Jones et al. disclose all the limitations required by the claims except for the fibers of the mesh being hydratable polymers. See Examiner's Response above. Chen cures this deficiency by disclosing why one of ordinary skill in the art would want to use water hydratable polymers as the fibers of Jones et al., which is to increase the integrity and resiliency of the device without subtracting from absorbent attributes desired in an absorbent material, as disclosed by Chen et al., therefore encompassing claims 23-27 and new claim 33.

Claims 7-10, 19-28, 30, 31, 33 and 34 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612